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IS AN ABRIDGMENT AN INFRINGEMENT OF THE COPYRIGHT OF THE ORIGINAL WORK?

"Many cases [are] to be found in the reports, which decide that a *bona fide* abridgment of a book is not an infringement of copyright." It not unfrequently happens that when the foundation of what is without hesitation taken or asserted as an established legal principle, is sought for, it is found to be of no more solid a character than an accumulation of *dicta* made in the course of a series of decisions relating to other branches of the same general subject. There may be in fact not a single case in which the precise point has arisen; and yet *dicta* on that point been so often and so broadly and confidently enunciated, that bearing upon their face the semblance of authority, when the case actually does arise which calls for a direct and positive decision upon the very question, the judicial mind, misled by appearances, may yield to the supposed pressure of authority, and feel compelled to decide upon the maxim *stare decisis* against the bent of its inclination from reason and principle. It may not be without a practical bearing, therefore, to examine the grounds for the *dictum* which stands at the commencement of this article, and which is to be found in the opinion of Mr. Justice Grier in *Stowe* vs. *Thomas*, (2 Am. Law Reg.

210; 2 Wallace, Jr. 547, 566,) where the point before the Court was, Whether a translation into another language is an infringement of the copyright in the original work, where such original work is protected by copyright in the same country in which such translation is printed, published, imported, or offered for sale?

The most recent case upon the point, is *Story's Ex'rs* vs. *Holcombe et al.*, (4 McLean, C. C. R. 306,) decided by Mr. Justice McLean in the Ohio district in 1847. An injunction was sought by the representatives of the late Mr. Justice Story as holders of the copyright in his "Commentaries on Equity Jurisprudence," to restrain the defendants from printing and publishing "An introduction to Equity Jurisprudence, on the basis of Story's Commentaries, etc., by James P. Holcombe." Defence—that the work complained of was a *bona fide* abridgment of the Commentaries." In the outset of the opinion the Court state, "the decision must turn on the question of abridgment;" and yet by reference to the conclusion of the opinion, it will be seen that an injunction was granted against the first hundred pages of the work complained of, as being a compilation and as such an "infringement of the plaintiff's rights, on the ground that the plan of the Commentaries is copied; and also for the reason that the extracts extend beyond the proper limit for such a work." And this had the same practical effect as an injunction against the whole book. "The remaining two-thirds of the book *may be* comprehended *under a liberal construction* of an abridgment." There is in this language no positive refusal of an injunction against the remainder of the book on the ground of its being a fair abridgment and therefore no infringement.

But, although not required by the circumstances of the case before him, the learned judge decides that a "fair abridgment" is no infringement. This decision is made solely on the ground of authority, for he expressly states "the reasoning on which the right to abridge is founded, seems to me to be false in fact," and he recognizes the same test of infringement as that suggested by Mr. Curtis, (Copyright p. 240,) viz: "Is the legitimate tendency of the act complained of to injure the original author?" He goes on to state, "But a contrary doctrine has been long established in Eng-

land; and in this country the same doctrine has prevailed. I am, therefore, bound by precedent; and I yield to it in this instance, more as a principle of law, than a rule of reason or justice."

What authorities are cited to sustain this position? First in point of time is *Gyles* vs. *Willcox*, (2 Atk. 141, an. 1740), where an injunction was asked against a work entitled "Modern Crown Law," alleged to be an infringement of Lord Hale's "Historia Placitorum Coronæ." The injunction was granted on the ground that the work complained of was a "merely colorable" shortening, by which "some words out of the Historia are left out only, and translations given instead of the Latin and French quotations that are dispersed through Sir Matthew Hale's work." In the course of the decision, however, Lord Hardwicke says, "Abridgments may with great propriety be called a new book, because not only the paper and print, but the invention, learning and judgment of the author is shown in them, and in many cases are extremely useful, though in some instances prejudicial, by mistaking and curtailing the sense of the author." This *dictum* was thrown in merely to prevent the decision being considered as an authority for more than the point actually before the Court; a purpose which is defeated, if the reservation properly made is to be regarded as an absolute ruling of the case reserved for decision when it should present itself. It is true that in *Tonson* vs. *Walker*, (3 Swanst. R. 679,) Lord Eldon, remarks in reply to a suggestion in the course of the argument, "In *Gyles* vs. *Willcox*, the abridgment contained 35 sheets, the original 276, it was referred to award, and held a fair abridgment and not within the Statute." But as *Gyles* vs. *Willcox* was decided in 1740, and Lord Eldon was born in 1751, he could not have spoken from any personal knowledge on the subject of the case, and especially when he was but thirteen years old at the time of Lord Hardwicke's death. The remark, therefore, must be taken *cum grano salis*, and not received as authoritative as to the final result of *Gyles* vs. *Willcox*, when no mention of it subsequent to the reference, is made by any of the reporters.

An *Anonymous Case* in Lofft, 775, (an. 1774), is the next authority cited by Mr. Justice McLean. The application was for an

injunction against Newberry's abridgment of Dr. Hawkesworth's Voyages, and was heard before Lord Bathurst, whom Lord Campbell, (Lives of the Lord Chancellors, Chap. 52, Vol. 5, p. 336, Amer. edit.) pronounces "little qualified for intellectual pursuits." Had it not been for the fact that Sir William Blackstone was consulted upon the case, the intrinsic weight of this authority would be very little. The ground upon which it is rested is, that "to constitute a true and proper abridgment of a work, *the whole must be preserved in its sense;* and then the act of abridgment is an act of the understanding employed in carrying a large work into a smaller compass, and rendering it less expensive and more convenient both to the time and use of the reader, which made an abridgment *in a measure* a new and meritorious work." And, therefore, "An abridgment when the understanding is employed in retrenching unnecessary and uninteresting circumstances which rather deaden the narration, is not an act of plagiarism upon the original work, nor against any property in the author of it, but an allowable and meritorious work." If the principle here laid down is a just one, it would authorize some of the most barefaced literary thefts. This abridgment would seem from the language of the Chancellor to have been a mere retrenchment of what was considered by Mr. Newberry as "unnecessary and uninteresting" matter; and must, therefore, be considered as overruled by the late case of *Bohn* vs. *Bogue*, (10 Lond. Jur. 420, an. 1846,) where Mr. Hazlitt the editor of "*A Life of Lorenzo de Medici*," published by defendant, avowedly founded upon Mr. Roscoe's "*Illustrations of the Life of Lorenzo de Medici*," the copyright of which was held by plaintiff, "first of all threw overboard as utterly worthless—as of no use whatever to anybody—of no interest whatever—the greatest part of the work" which he made the basis of his own publication, but used and copied what he thought of most value; and an injunction was granted. And the note of the case of *Trusler* vs. *Murray*, (an. 1789, 1 East, 362, n.,) throws much doubt on the case in Lofft. "In this case though some parts of the chronological work were different, yet in general it was the same, and in particular pages 20 to 34 was a literal copy. Lord Kenyon was of opinion that plaintiff could recover. Lord

Bathurst had been of that opinion, and he thought rightly, with respect to the publication of some original poems by Mr. Mason with others before published, *and the like with respect to an abridgment of Cook's Voyages around the World.*"

The third and last English case relied upon is *Bell* vs. *Walker*, (1 Bro. C. C. 451, an. 1785.) Passages were read from the two works to show that the facts and even the terms in which they were related in the book against which an injunction was prayed were taken frequently *verbatim* from the original work. Sir Thomas Sewell, M. R. said, "If this was a fair *bona fide* abridgment of the original work, several cases in this Court had decided an injunction should not be granted. It had been so determined with respect to to Dr. Hawkesworth's Voyages. He should not decide at present *whether it were such*, or a piracy from the former. But he had heard sufficient read to entitle the plaintiff to an injunction till answer and further order." Now the only reported prior case touching on abridgments in addition to those already commented upon is *Dodsley* vs. *Kinnersly*, (Ambler, 403, an. 1761,) in which the narrative part of Johnson's Rasselas had been published by defendant, omitting the moral reflections. And Sir Thomas Clark, M. R., in delivering his opinion refusing an injunction, says, "What I materially rely upon is, that it could not tend to prejudice the plaintiffs when they had before published an abstract of the work in the London Chronicle." The authority of *Bell* vs. *Walker* can be regarded as of no more weight than can be attached to a *dictum* entirely uncalled for by the case before the Court. The case of *Read* vs. *Hodges*, (an. 1740,) is cited in *Gyles* vs. *Willcox* as if it was an authority upon the question with reference to abridgments; but the infringement complained of was in fact a *verbatim* reprint of plaintiff's work, only several pages left out bodily.

The only American authority cited to sustain the position that in this country the same doctrine has prevailed, is *Folsom* vs *Marsh*, an. 1841, (2 Story R. 106.) The question in this case arose upon the publication by defendants, of a Life of Washington, which was alleged to be an infringement of Mr. Sparks' Life and Writings of George Washington. Three hundred and nineteen pages of defend-

ants' work had never appeared in print before they were published by plaintiffs, and were reported by the Master to whom it was referred to ascertain the facts (and his report was not excepted to) to have been copied from plaintiffs' book. And upon this ground, viz: that parts of the work "imparting to it its greatest, nay, its essential value" were copied from the plaintiffs', an injunction was granted. "But," says the learned judge, "if it had been the case of a fair and *bona fide* abridgment of the work of the plaintiffs it might have admitted of a very different consideration." And in the preliminary or introductory part of his opinion he uses the following language. "It has been decided that a fair *bona fide* abridgment of an original work is not a piracy of the copyright of the author. But then, what constitutes a fair and *bona fide* abridgment in the sense of the law is one of the most difficult points under particular circumstances, which can well arise for judicial decision. It is clear, that a mere selection—a different arrangement of parts of the original work, so as to bring the work into a smaller compass, will not be held to be such an abridgment. There must be real substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work.'' As the case, however, did not call for the decision of the question now under examination, it cannot be regarded as expressly ruling the point; although a *dictum* of Mr. Justice Story is entitled to much weight. To sustain this *dictum*, the cases of *Whittingham* vs. *Wooler*, (2 Swanst. R. 428) and *Tonson* vs. *Walker*, (3 id. 672,) in addition to the cases of *Dodsley* vs. *Kinnersley*, and *Gyles* vs. *Willcox*, already mentioned, are cited. *Whittingham* vs. *Wooler* was a case where the defendant had inserted in a periodical work of theatrical criticism, detached extracts to the extent of six or seven pages from a farce, the property of the plaintiffs, interspersed with criticism. It was not pretended or argued that any question as to abridgment was presented by the case. In *Tonson* vs. *Walker*, an injunction was granted to restrain the publication of Dr. Newton's Notes to Milton's Poems, notwithstanding a small addition of original commentary by the defendant. It was a case of *verbatim* copy-

ing; and yet Lord Eldon travels out of the way to say, that "a fair abridgment would be entitled to protection."

Such are the authorities by which Mr. Justice McLean felt himself bound, contrary to the dictates of his own reason on grounds of principle. The only remaining cases upon which the *dictum* of Mr. Justice Grier in *Stowe* vs. *Thomas* can rest, are *Butterworth* vs. *Robinson*, (5 Ves. 709;) and *Gray* vs. *Russell*, (1 Story R. 11.)

The report of *Butterworth* vs. *Robinson* is exceedingly meagre; but shows that the work complained of and against which an injunction was granted, was with the exception of leaving out some parts of the cases, a mere copy *verbatim* of among others the Term Reports, of which the plaintiff was proprietor, comprising all the cases published in that work. There is no discussion of principles in the decision of the Lord Chancellor as reported; and the case goes no farther than to decide that a *verbatim* reprint of parts of an original work cannot be covered up under the title of an abridgment. In *Gray* vs. *Russell*, it was not pretended that the work complained of was an abridgment, for so literal had been the transcription that the defendant "incorporated the very errors of plaintiff's work. But Mr. Justice Story after stating, that "In some cases, indeed, it may be a very nice question what amounts to a piracy of a work or not;" and entering into a discussion with reference to extracts for the purpose of criticism and review,—abridgments,—and Law Reports; says expressly, "We are spared from any nice inquiries of this sort in the present case." The point in question did not come up for decision.

It would seem, therefore, from an examination of the authorities, that there is in reality no case in which the question has been presented for direct decision, Whether an abridgment (no matter how *bona fide*) is an infringement of the copyright of the original?—

Should it then be regarded as finally and definitively settled? The reason of other judicial minds besides Mr. Justice McLean's, does not assent to what seems to have been tacitly received as an established principle. Lord Campbell (Lives of the Lord Chancellors vol. 5. p. 72, Amer. edit.) says, "I must own, that I much question another rule he [Lord Hardwicke] laid down with respect to literary property, although it has not yet been upset. *Gyles* vs.

Willcox, (2 Atk. 142) and see Lofft, 775. I confess I do not understand why an abridgment tending to injure the reputation, and to lessen the profits of an author, should not be considered an invasion of his property." When an actual case presenting the precise point is presented for judicial determination and expressly decided, it will be time enough to regard the question as settled by authority.

Till then, however, it must still be regarded as open for discussion.

In the Circuit Court of the United States for the Hartford District.

THE AMERICAN PIN COMPANY *vs.* THE OAKVILLE COMPANY ET AL.

1. The extent of the rights secured to the patentee stated, and the case of *O'Reilly* vs. *Morse* cited and affirmed.
2. The means specified in the patent to produce the effect, and nothing more, are secured to the patentee, and there can be no infringement unless the same substantial means are used in both the plaintiffs' and defendants' machines.

The facts of this case fully appear in the opinion of the Court, which was delivered by

INGERSOLL, J.—The complainants, by their bill seek to enjoin the defendants from using a machine to paper pins, the right to use which, they claim to be exclusively vested in them. The foundation of their claim rests upon two certain patents, the right to which Patents, with the privilcges by such patents granted, they now have by virtue of assignments from the patentees. One of these patents, was issued to Samuel Slocum, and bears date the 30th day of September, A. D. 1841, and was to run for fourteen years from the last mentioned date. The other Patent was issued to John J. Howe, and bears date the 24th of February, A. D. 1843, and was to run fourteen years from the 5th day of December, A. D. 1852. The validity of these patents is not contested by the defendants. They admit that the complainants have all the rights which these Patents purport to grant. They admit further, that they are using a machine for papering pins; but they deny, that by such use, they have infringed upon any of the rights so granted by such patents.